

1-21 (cancelled).

22 (original). A colored contact lens comprising a non-opaque pupil region, a generally annular-shaped iris region surrounding the pupil region and adapted to cover at least 80% of a wearer's iris when the wearer is wearing the contact lens, a multi-color composite pattern on the iris region, the composite pattern comprising a plurality of distinct elements, each of at least 25% of the elements having a surface area no greater than 6000 square microns.

23 (original). A colored contact lens as set forth in claim 22 wherein each of at least 25% of the elements have a surface area no greater than 4000 square microns.

24 (original). A colored contact lens as set forth in claim 22 wherein each of at least 25% of the elements have a surface area no greater than 2000 square microns.

25 (original). A colored contact lens as set forth in claim 22 wherein each of at least 25% of the elements have a surface area no greater than 1000 square microns.

26 (original). A colored contact lens as set forth in claim 22 wherein the composite pattern covers at least 30% of the iris region.

27 (original). A colored contact lens as set forth in claim 22 wherein the composite pattern covers at least 50% of the iris region.

28 (original). A colored contact lens as set forth in claim 22 wherein the composite pattern comprises at least 800 distinct elements.

29 (original). A colored contact lens as set forth in claim 22 wherein the composite pattern comprises at least 3000 distinct elements.

30 (original). A colored contact lens as set forth in claim 22 wherein each of at least 20% of the elements are within 50 μm of an adjacent one of the elements.

31 (cancelled).

32 (cancelled).

33 (cancelled).

34 (cancelled).

35 (cancelled).

36 (cancelled).

37 (cancelled).

38 (cancelled).

39 (original). A colored contact lens comprising a non-opaque pupil region, a generally annular-shaped iris region surrounding the pupil region and adapted to cover at least 80% of a wearer's iris when the wearer is wearing the contact lens, a multi-color composite pattern on the iris region, the composite pattern comprising at least 3000 distinct elements.

40 (original). A colored contact lens as set forth in claim 39 wherein each of at least 20% of the elements are within 50 μm of an adjacent one of the elements.

41 (cancelled).

42 (cancelled).

43 (previously added). A colored contact lens comprising a non-opaque pupil region, a generally annular-shaped iris region surrounding the pupil region and adapted to cover at least 80% of a wearer's iris when the wearer is wearing the contact lens, a multi-color composite pattern on the iris region, the composite pattern comprising at least 3000 distinct elements, each of at least 20% of the distinct elements being within 10 μm of an adjacent one of the elements.

44 (previously added). A colored contact lens as set forth in claim 43 wherein each of at least 30% of the elements are within 10 μm of an adjacent one of the elements.

A. Claims 22-27 Are Not Made Obvious By Neefe U.S. Patent No. 4,701,038.

Independent claim 22 is directed to a colored contact lens having, among other things, a multi-color composite pattern on the iris region. The composite pattern comprises a plurality of distinct elements.

The Neefe patent discloses a cosmetic contact lens, which is formed by cutting a disc from a cylinder. The cylinder has a transparent center 3 surrounded by a transparent colored polymer 1. Light reflecting particles 5 are imbedded in the colored polymer. The light reflecting particles 5 "have no color of their own." Column 3, lines 34-35. The Neefe patent does not disclose a multi-color composite pattern on a contact lens. Rather the colored polymer is of a single color. The Neefe patent also does not disclose or suggest any multi-color pattern or any color pattern.

The Office takes the position that Neefe's disclosure of "pigments" being mixed together would make obvious to a person of ordinary skill in the art a multi-color pattern. The Office asserts that mixing pigments together "will inherently produce more than one color i.e. multi-color." It appears that the Office position is that if the pigments are not thoroughly mixed, then variations of color will exist, thus making more than one color. Of course, if two or more pigments are thoroughly mixed, then the resulting product will be a single unitary color. The Neefe patent does not disclose or suggest a partial mixing of pigments. Therefore, the Neefe patent does not disclose or suggest a multi-color pattern.

The Neefe patent itself provides no disclosure, suggestion, or teaching for a multi-colored composite pattern. The Office has not rejected any claims of the present

application based in whole or in part on Thakrar U.S. patent 6,284,161 ("the Thakrar patent). The Office cites the Thakrar patent merely as an example of a disclosure of a contact lens having a multi-color pattern. However, there is no motivation, suggestion, or teaching in the Thakrar patent or in any other prior art reference of record for modifying the Neeffe contact lens to provide a contact lens as required by Applicant's claims. Thus, Applicant respectfully submits that the Office has not met its burden of establishing that the Neeffe patent makes obvious Applicant's claim 22.

The Office characterizes Neeffe's colorless light reflecting particles as somehow being elements of a multi-color composite pattern. A particle that is colorless cannot be construed as an element of a multi-color composite pattern. For this additional reason, the Neeffe patent does not make obvious Applicant's claim 22.

Claims 23-27 depend from claim 22. Accordingly, claims 23-27 are not made obvious by the Neeffe patent for the same reasons that claim 22 is not made obvious. Thus, the rejection of claims 22-27 based on the Neeffe patent should be withdrawn.

B. Claims 22-27 Are Not Made Obvious By The Ocampo Publication.

The Office asserts that the pigments of three microns or smaller disclosed in the Ocampo Publication constitute the distinct elements required by Applicant's claim 22. However, pigments disclosed in the Ocampo Publication are the pigments used in the manufacture of the contact lens. There is no disclosure or suggestion in the Ocampo Publication of a contact lens itself having distinct elements of three microns or smaller.

The Office then addresses pixel sizes disclosed in the Ocampo Publication. The Office notes that the Ocampo Publication discloses a pixel diameter of 100 microns and calculates the area of such a pixel as being 7,850 square microns. The Office notes

that Applicants' claimed distinct element area sizes of 6000 square microns (claim 22), 4000 square microns (claim 23), 2000 square microns (claim 24), and 1000 square microns (claim 25) are less than that disclosed by the Ocampo Publication, but asserts that changes in size or in ranges are not patentable distinctions. However, the cases cited by the Office are inapplicable to the present case. The cases cited by the Office involved optimization of products falling within known ranges. The subject matter of *In re Rose* was large pieces of lumber. Large pieces of lumber existed prior to *In re Rose*. Size was not deemed to be a patentable distinction in *In re Rose* because large pieces of lumber were known. The subject matter of *In re Aller* was a process for decomposing isopropyl benzene and required the optimization of a temperature range and concentration range. According to the evidence of record in that case, experimentation to find the optimum conditions of temperature and acid concentration was within the expected skill of a chemical engineer at the time of the invention.

In re Rose and *In re Aller* do not overrule and do not nullify the numerous court decisions concerning the requirement for presentation of a *prima facie* case of obviousness. To present a *prima facie* case of obviousness, the Office must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed.Cir.1988). The Office must show that the "cited references, either alone or in combination, [suggest or teach Applicant's] invention." *Id.* In the present case, the Office has made no such showing. The Ocampo reference does not disclose, suggest or teach Applicant's claimed requirements of each of at least 25% of the elements of a multi-color composite pattern

having a surface area: no greater than 6000 square microns (as required by claim 22), 4000 square microns (as required by claim 23), 2000 square microns (as required by claim 24), or 1000 square microns (as required by claim 25). Because the Office has failed to provide any evidence that the small element sizes required by Applicant's claims were known or made obvious prior to Applicant's invention, claims 22-25 are patentable over the prior art of record.

Claims 26 and 27 depend from claim 22 and are therefore not made obvious by the Ocampo Publication for the same reasons that claim 22 is not made obvious by the Ocampo Publication.

C. Claims 28-29 and 39 Are Not Made Obvious By The Ocampo Publication and the Atkins patent.

Claims 28 and 29 depend from claim 22. For the reasons discussed above, the Ocampo Publication does not make obvious Applicant's claim 22 because the Ocampo Publication does not disclose or suggest claim 22's requirement of "each of at least 25% of the elements [of the composite pattern] having a surface area no greater than 6000 square microns." Atkins U.S. Patent 6,132,043 ("the Atkins Patent"), whether considered alone or together with the Ocampo Publication also does not suggest the requirements of Applicant's claim 22. Thus, the Ocampo Publication and the Atkins patent, whether considered together or separately, fail to make obvious Applicant's claim 22. Because claims 28 and 29 depend from claim 22, the Ocampo Publication and the Atkins patent also fail to make obvious Applicant's claims 28 and 29.

Claim 29 further requires the composite pattern to comprise at least 3000 distinct elements. The Office cites to Figure 1 of the Atkins patent and to column 2, lines 3-14 of such patent in asserting that the Atkins patent teaches that the patterning can have

“at least 3000 dots to provide the required enhanced cosmetic appearance.” However, the pattern shown in Atkins Figure 1 does not have anywhere near 3000 dots and column 2, lines 3-14 provides no teaching and no suggestion of a pattern having anywhere near 3000 dots. The Office then characterizes Atkins column 3, lines 32-36 as teaching “that the patterning can have more or less dots to provide the required cosmetic appearance.” However, Atkins column 3, lines 32-36 states:

The elements of the pattern are preferably opaque dots. Certain portions of the iris section 22 may be more or less densely covered with dots than other portions. This arrangement enhances the structure of the iris of a person wearing the lens.

The quoted language from Atkins discloses merely that some portions may be more or less densely covered with dots than other portions. This provides no suggestion of increasing the total number of dots. After all, changing the density of relative portions of the pattern can be accomplished by changing the location of the dots without changing the number of dots. The quoted portion of Atkins provides no disclosure or suggestion of increasing the number of dots and certainly provides no disclosure or suggestion of increasing the number of dots to at least 3000 as required by Applicant’s claim 29. The Atkins patent and the Ocampo Publication, whether considered together or separately, provides no motivation, suggestion or teaching of a contact lens having the requirements of Applicant’s claim 29.

The Office asserts that claim 29’s requirement of “at least 3,000” is mere optimization of a range. However, claim 29 does not specify a range at all. A range would require a minimum and a maximum. Claim 29 specifies a minimum only. Thus, claim 29 does not specify a range. The Office states that “where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges

involves only routine skill in the art.” Regardless, the cited prior art does not disclose the general conditions of claim 29 in that the cited prior art does not disclose a composite pattern comprising at least 3000 distinct elements. Moreover, the cases cited by the Office do not overrule and do not nullify the numerous court decisions concerning the requirement for presentation of a *prima facie* case of obviousness. To present a *prima facie* case of obviousness, the Office must show “some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 5 USPQ2d 1596, 1598 (Fed.Cir.1988). The Office must show that the “cited references, either alone or in combination, [suggest or teach Applicant’s] invention.” *Id.* The Office has not shown that the Atkins patent and the Ocampo Publication, either alone or in combination, suggest or teach claim 29’s requirement of a composite pattern comprising at least 3000 distinct elements. Thus, the rejection of claim 29 should be withdrawn.

Claim 39, like claim 29, requires a multi-color composite pattern comprising at least 3000 distinct elements. For the reasons discussed above with respect to claim 29, the Office has not shown that the Atkins patent and the Ocampo Publication, either alone or in combination, suggest or teach claim 39’s requirement of a composite pattern comprising at least 3000 distinct elements. Thus, the rejection of claim 39 should be withdrawn.

D. Claims 30 and 40 Are Not Made Obvious By The Ocampo and Tucker Publications.

Claim 30 depends from claim 22 and therefore has all of the limitations of claim 22. For the reasons discussed above, the Ocampo Publication does not make obvious

Applicant's claim 22. The Ocampo and Tucker Publications, whether considered together or separately, fail to disclose or suggest the requirements of claim 22.

Likewise, the Ocampo and Tucker Publications, whether considered together or separately, fail to disclose or suggest the requirements of claim 30. Moreover, there is no motivation, suggestion, or teaching for combining the teachings of the Ocampo and Tucker Publications. Thus, claim 30 is not made obvious by the Ocampo and Tucker Publications.

Claim 40 depends from claim 39 and therefore has all of the limitations of claim 39. Claim 39 requires a multi-color composite pattern comprising at least 3000 distinct elements. The Ocampo and Tucker Publications, whether considered together or separately, fail to disclose or suggest the requirements of claim 39. The Office has pointed to no disclosure or teaching of either Ocampo or Tucker concerning the requirements of claim 39. For this reason, claims 39 and 40 are not made obvious by the Ocampo and Tucker Publications. Moreover, there is no motivation, suggestion or teaching for combining the teachings of the Ocampo and Tucker Publications. Thus, claim 40 is not made obvious by the Ocampo and Tucker Publications.

E. Claims 43 and 44 Are Not Made Obvious By The Atkins Patent and Tucker Publication.

Claim 43 requires a colored contact lens comprising a multi-color composite pattern having at least 3000 distinct elements, and requires each of at least 20% of the distinct elements being within 10 microns of an adjacent one of the elements. These references fail to disclose or suggest a multi-color composite pattern having at least 3000 distinct elements and fail to disclose or suggest each of at least 20% of the distinct elements being within 10 microns of an adjacent one of the elements. Moreover, the

disclosure of the Atkins patent teaches away from placing the dots of Atkins too close together. In particular, the Atkins patent emphasizes that it is important to "leave a substantial portion of the iris section within the interstices of the pattern non-opaque."

Atkins, column 3, lines 43-45. The Atkins patent reiterates this at column 3, lines 54-55, and at column 4, lines 65-67. Because the Atkins patent teaches away from the requirements of claim 43, the Tucker Publication cannot be combined with the Atkins patent to present a *prima facie* case of obviousness. Thus, claim 43 is not made obvious by the Atkins patent and Tucker Publication. Claim 44 depends from claim 43 and is therefore patentable over the Atkins patent and Tucker Publication for the same reasons as claim 43.

**F. Response Concerning The Telephone Conversation Of
July 24, 2003.**

During the telephone conversation with the Examiner on July 24, 2003, Applicant's undersigned counsel questioned why the Office issued a non-responsive action in response to Applicant's May 9, 2003 written communication. Applicant's counsel pointed out that the written communication responded to all of the rejections in the December 9, 2002 Office Action and was therefore responsive to the Office Action even if the Examiner disagreed with the arguments presented in the written communication. The Examiner said that he could replace the non-responsive action with a final rejection. Because Applicant's counsel did not know how to respond to the non-responsive action, he told the Examiner that he would prefer a final rejection since he could at least respond to a final rejection. The Examiner indicated that he would do so.

The Examiner indicates that Applicant's counsel was discourteous or unprofessional, but does not specify what Applicant's counsel said that was discourteous or unprofessional. The Examiner had been helpful in previous telephone conversations and Applicant's counsel appreciated such helpfulness. Applicant's counsel called the Examiner on July 24, 2003 merely seeking a withdrawal of the non-responsive action. No issue was debated and the conversation lasted only a couple of minutes. Applicant's counsel does not understand what statement he made that the Examiner deemed to be discourteous or unprofessional and would appreciate elaboration by the Examiner. Applicant's counsel did not intend to offend the Examiner in any way. Apparently, the Examiner misinterpreted Applicant's counsel. The Examiner should be assured that in future conversations with the Examiner, Applicant's counsel will endeavor to minimize the possibility of any statements being construed as offensive.

G. Conclusion

For the reasons disclosed above, Applicant requests that the Office withdraw all of the claim rejections. Applicant further requests that the Office issue a notice of allowance, allowing all pending claims.

Respectfully submitted,

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